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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,630	07/06/2000	HIROSHI OKUBO	106348	1399

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EXAMINER

ONEILL, MICHAEL W

ART UNIT	PAPER NUMBER
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3713

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DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,630

Applicant(s)

OKUBO ET AL.

Examiner

Michael O'Neill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 13-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 25-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

The Examiner acknowledges Applicants' election of claims 1-12 and 25-36. Claims 13-24 are withdrawn from consideration. The Examiner acknowledges the Applicants' traversal of the election. Respectfully, upon review, the traversal is unpersuasive for the reasons given below.

First, Applicants conclude "Group I is a combination with respect to what are characterized in the Office action as subcombinations." Applicants provide no specific reasons to base the Applicants conclusion that Group I is a combination of the subcombinations of Groups II, III and IV. Reading the claims, it is quite clear that Group I is a subcombination of a game machine for using an optical disk using the synchronization means thereon and a process of reading an optical disk to utilize synchronization means thereon. Whereas, Group II is a subcombination of an information storage medium that includes synchronization data thereon; while Groups III and IV are directed to subcombinations of a musical tone reproduction device and an information storage medium containing reproduction information for a time and synchronization information for the tunes' reproduction and image reproduction; all respectively. If the Applicants' believe the requirement to restrict is in

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error with respect to Group I being and combination of the subcombination of Groups II and IV, then the Applicants need to demonstrate the specifics of Groups II and IV are the same specifics in Group I, i.e. ABsp/Bsp equals no restriction because the subcombination is essential to the combination, see MPEP 806.05(c).

Second, with respect to placement of claims 13-15 into the subcombination of Group II, the grouping reflects the subcombination of an information storage medium including synchronization data thereon. Claims 13-15 claim optical disks comprising synchronization data. "Comprising" and "including" are considered natural synonyms in the English language, see The New American Roget's College Thesaurus In Dictionary Form, ©1985. Therefore, claims 13-15 as read and understood in English better fit into Group II than any other of the subcombination listings. If the Applicants wish, the Examiner could subdivide the subcombination of Group II into separate subcombinations of Group IIA drawn to an optical disk including synchronization data thereon and Group IIB a subcombination of an information storage medium including synchronization data. However, the Examiner advises the Applicants not to take this option because the Examiner's position is that these fictional subcombinations of Group IIA and IIB could not hold separate

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patents, i.e. the Applicants would have to file a terminal disclaimer because of the judicially created doctrine of obvious-type double patenting, i.e. non-statutory double patenting, see MPEP 804.02, would be raised by the Examiner.

Third, the Applicants still conclude there has been a holding of lack of unity of invention. Respectfully, this maintained conclusion is in error. As stated and demonstrated in the previous Office action there are no special technical features within these claims as presented. Therefore, without any special technical feature there can be no holding of lack of unity of invention, said holding of lack of unity is inapplicable in such cases, see MPEP 1850. "Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art." Because, as evidenced by the Search Report, special technical features are lacking, the issue of unity vel non is never reached and thus the PCT Rules for lack of unity do not apply. What rules that do apply are the statute 35 U.S.C. § 121, regulation 37 CFR 1.142 and MPEP Chapter 800.

Fourth, the Applicants conclude that the subject matter of the Groups is "sufficiently related that a thorough search of Group I would encompass a search for Groups II and III. The Applicants' reasoning for this conclusion is because all three groups are classified in the same Class, Class 463. Respectfully, the Examiner disagrees with the Applicants conclusion and reason. It is obvious that all groups are in at least different subclasses of Class 463, thus different classification is shown because the Patent Office still uses the Class and subclass classification system to classify a given application into an art and assign it to an examiner. Moreover, the Applicants' reason that Groups I, II and III are in the same class is in error. As seen in the previous Office action, Group III is classified in Class 84, subclass 600, which is the location where all electronic musical tone reproduction devices are classified and examined by examiners in that art. Second, as mentioned in the restriction requirement the search for Group I would be different for that of Group II. For example, because the subcombination of Group II is classified in 463/31 (enhanced graphic processing); a thorough search would require the examiner to consult an examiner and search the art of graphic processing of Class 345. Because the subcombination of Group I is directed to a game machine with an optical disk; a thorough

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search would require consultation and search in the hardware computer-related arts of the "700" Classes because a game machine is a computer, abet a computer that is specialized for game software instead of application software like word processing, spreadsheets, database management, etc. Therefore, as shown above, it would a serious burden on the Examiner to search more than just one invention in this application.

Thus, the Applicants traversal is unpersuasive for the reasons *supra* and the requirement for restriction is FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 8, 11, 12, 29-32, 35 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re. claims 7 and 8: "the controller" lacks antecedent basis.

Re. claims 11 and 12: "the optical signal output section" lacks antecedent basis.

Re. claims 29 and 30: "the display section" lacks antecedent basis.

Re. claims 31 and 32: "the controller" lacks antecedent basis.

Re. claims 35 and 36: "the optical signal output section" lacks antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 and 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Takamori et al., USPN 6,041,067.

Takamori et al. discloses a device that synchronizing at least visual data, i.e. synchronizing the main visual picture data to the sub visual picture data that can be utilized in a game machines, see col. 1:14-19; thus, meets the preamble limitations. The device disclosed in Takamori describes an optical disk means with at least synchronized data for

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synchronizing at least image data, see figure 12 for the optical disk and see figure 13 for the sync. data; in which is (11b) system clock reference (SCR) and (11c) is the presentation time stamp (PTS) and (11d) is the packet data which includes the image data that is divide in the disclosure as main picture data and sub-picture data. Disclosed in the reference is means for reproducing image data based on the data contained on the optical disk, see figure 11 which discloses the prior art MPEG reproduction means. Likewise, disclosed in the reference is the means for executing given processing in synchronization with images to be reproduced by the reproduction means, see col. 3:8-18 which describes the process of synchronizing a given frame at a given time. Because clock speeds are in milliseconds, if not short depending on the equipment, the accessibility of the data appears virtually simultaneously as understood by those in the art. Takamori et al. synchronization data starts at time = 0, this meets the limitation of data indicating elapsed time since reproduction start. All video game machines render the graphics onto the display sections of said machines. Likewise, in order for any game to function effectively, synchronization is needed with respect to the controller or any other input means.

Re. claims 11, 12, 35 and 36, as best understood by one of ordinary skill in the art, "the optical signal output section"

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appears to be structure the reading of the optical disk and sending the data read onto the processor for processing and execution. It would be inherent in any game machine with a DVD or CD drive would include a head end that scans, reads and distributes the data in an optical format and synchronizes that data based on the time stamp data incorporated into each data packet on the optical disk.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9, 10, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takamori et al.

The type of input and output means for a game machine in order for the user to experience the game is an obvious design choice left to the inventor's discretion which would be based upon the marketing factors for any game and any cost to develop such input and output structures, absent a showing of criticality for the particular input and output means for the player to experience the game program stored on the game software medium utilized.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 703-308-3484. The examiner can normally be reached on Monday through Thursday 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-1118. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MON

May 20, 2003

A handwritten signature in black ink, appearing to read "M O'NEILL", with a long horizontal stroke extending to the left.

**MICHAEL O'NEILL
PRIMARY EXAMINER**